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Amendment D

REMARKS

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the foregoing amendments and the following remarks is respectfully requested.

New claims 34 – 39 are presented for the Examiner's consideration. Claims 2, 12, 13, 16, 17, and 22 were canceled in a previous response. Claims 1, 3 – 11, 14 – 15, 18 – 21, and 23 – 33 are presently canceled.

Support for Claim 34 can be found at least at: original claims 1, 3, 15, and 16 and page 6: 1; page 11: 11 – 13; page 27: 20 through page 28: 2; page 28: 14 – 18.

Support for Claim 35 can be found at least at: page 22: 10 – 18; page 23: 11 – 13 and the citations listed for claim 34 above.

Support for Claim 36 can be found at least at: original claim 19 and the citations listed for claim 34 above.

Support for Claim 37 can be found at least at: original claim 18 and the citations listed for claim 34 above.

Support for Claim 38 can be found at least at: original claim 5 and the citations listed for claim 34 above.

Support for Claim 39 can be found at least at: original claim 14 and page 7: 7 and the citations listed for claim 34 above.

No new matter has been added.

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ARGUMENTS

By way of the Office Action mailed 08/30/2004, claims 1, 3 – 11, 14 – 15, 18 – 21, and 23 – 33 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The term "active" has been removed from the currently presented claims, as suggested by the Examiner, rendering the rejection moot. Applicants respectfully request that the rejection be withdrawn.

By way of the Office Action mailed 08/30/2004, claims 1, 3 – 11, 14 – 15, 18 – 21, and 23 – 33 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

The term "active" has been removed from the currently presented claims, as suggested by the Examiner, rendering the rejection moot. Applicants respectfully request that the rejection be withdrawn.

By way of the Office Action mailed 08/30/2004, claims 1, 3, 4, 9, 15, 18 – 21, 23, and 24 – 33 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated and thus unpatentable over PCT WO 95/19258. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. §2131. In addition, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. §2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989)).

Claims 1, 3, 4, 9, 15, 18 – 21, 23, and 24 – 33 have been canceled rendering this rejection moot. Applicants respectfully request this rejection be withdrawn. The currently presented claims 34 – 39 are patentably distinct over PCT WO 95/19258 ("Suzuki"). Applicants currently presented claims require, among other things, providing a backsheet web that expands to a second dimension when a force is applied and contracts after the force is removed and affixing an elastic material to the backsheet web to provide a flat cuff area. Suzuki teaches an elastic composite comprising an elastic sheet in its unstretched state partially bonded to a non-woven fabric in its unelongated state. The non-woven of Suzuki is not a backsheet web of an absorbent article and

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therefore fails to anticipate Applicants' claims. Even if one assumed the non-woven material of Suzuki were a backsheet web of an absorbent article, the non-woven does not expand when a force is applied and contract after the force is removed as required by the backsheet web of Applicants' claims. Furthermore, even if one were to assume the elastic composite of Suzuki were the backsheet web as claimed, an untensioned elastic material is NOT affixed to the elastic composite of Suzuki as required by the presently presented claims. Therefore Suzuki is not a proper basis for rejection in light of the currently presented claims because each and every element as set forth in the claims is not found either expressly or inherently therein.

By way of the Office Action mailed 08/30/2004, claims 1, 3, 4, 9, 15, 18 – 21, 23, and 24 – 33 alternatively stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over PCT WO 95/19258 in view of E.P. 650,714. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. §2142, 2143.

Claims 1, 3, 4, 9, 15, 18 – 21, 23, and 24 – 33 have been canceled thereby rendering this rejection moot. Applicants respectfully request that this rejection be withdrawn. The currently presented claims 34 – 39 are patentably distinct over PCT WO 95/19258 ("Suzuki") in view of E.P. 650,714 ("Coles") at least because the cited references fail to teach or suggest all the claim limitations. Coles teaches an elastic composite comprising a stretchable film in its relatively relaxed state laminated to a relatively unelongatable non-woven layer. The elastic composite of Coles is "activated" in that a physical deformation is applied to the unextensible layer to impart a permanent elongation to this layer. (Coles, col. 3). The teaching of Suzuki is discussed above. The combination of Coles and Suzuki fails to teach providing a backsheet web that expands to a second dimension when a force is applied and contracts after the force is removed and affixing an elastic material to the backsheet web to provide a flat cuff area as required by Applicants' currently presented claims. Therefore the combination of Suzuki and Coles is not a proper basis for rejection in light of the currently presented claims because each and every element as set forth in the claims is not found either expressly or inherently therein.

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By way of the Office Action mailed 08/30/2004, claim 14 stands rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over PCT WO 95/19258 in view of E.P. 650,714 further taken with any one of Roessler et al or Wideman. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

Claim 14 has been canceled, thereby rendering this rejection moot. Applicants respectfully request that this rejection be withdrawn. The currently presented claims 34 – 38 are patentably distinct over PCT WO 95/19258 ("Suzuki") in view of E.P. 650,714 ("Coles") further taken with any one of Roessler or Wideman because the cited references ("combination") fail to teach or suggest all the claim limitations.

Roessler teaches a method and apparatus for making elasticized absorbent articles having inboard and outboard leg elastics. Roessler also teaches securing the leg elastics to a substrate, but Roessler does not teach that the substrate expands to a second dimension when a force is applied and contracts after the force is removed as required by Applicants' claims. Therefore, the teaching of Roessler fails to cure the deficiencies of Suzuki and Coles as discussed above.

Wideman teaches a bulked web composite. The bulked composite of Wideman comprises a reticulated web of elastic held under differential tension bonded to at least one gatherable web. Wideman does not teach providing a backsheet web that expands when a force is applied and contracts when the force is removed with an elastic material affixed to the backsheet web as required by Applicants' claims. Therefore, the teaching of Wideman fails to cure the deficiencies of Suzuki and Coles as discussed above.

Therefore, Suzuki, Coles, Roessler, and Wideman, alone or in combination, fail to teach providing a backsheet web that expands to a second dimension when a force is applied and contracts after the force is removed and affixing an elastic material to the backsheet web to provide a flat cuff area as required by Applicants' currently presented claims. Therefore the combination is not a proper basis for rejection in light of the currently presented claims because each and every element as set forth in the claims is not found either expressly or inherently therein.

For at least any or all of the reasons stated herein, the foregoing rejections should be withdrawn. Consequently, Applicants submit that the Application, including Claims 34 - 39, is in condition for allowance and that action is earnestly solicited.

In the event the Examiner has any questions concerning this Response, the Examiner is invited to contact Attorney for Applicants at the telephone number listed below.

The Commissioner is hereby authorized to charge any fee(s) which may be required for this Response to Kimberly-Clark Worldwide, Inc., Deposit Account No. 11-0875

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Respectfully submitted,

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